

REMARKS

The present Amendment is in response to the Examiner's Office Action mailed December 23, 2008. Claims 2, 22, and 32 are canceled, with those elements being incorporated into amended independent claims 1 and 21, respectively. Claims 1, 3 – 21, 23 – 31, and 42 – 44 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicants' remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding. Also, Applicants arguments related to each cited reference are not an admission that the cited references are, in fact, prior art.

I. Rejection of claims 1 – 5 and 9 – 32 Under 35 U.S.C. § 102(b) as Anticipated by Hunsicker

The Examiner rejects claims 1-5 and 9-32 under U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,130,343 to Hunsicker *et al.* (hereinafter "*Hunsicker*"). *Hunsicker*, however, does not disclose, either expressly or inherently, each and every element independent claims 1 and 21 and, therefore, does not anticipate either claim.

Amended independent claims 1 recites a method that includes, *inter alia*, the step of dry mixing a binder with the tocopheryl succinate substance to produce a mixture.

Hunsicker does not expressly or inherently disclose the step of dry mixing a binder with the tocopheryl succinate. Indeed, *Hunsicker* discloses only mixing a binder in a solution with the tocopheryl, as each of the examples expressly states. Col. 7, ln. 18-67. Therefore, because *Hunsicker* fails to disclose each and every element of amended independent claim 1, the withdrawal of the 35 U.S.C. § 102(b) rejection of claim 1 is respectfully requested.

The withdrawal of the 35 U.S.C. § 102(b) rejections of dependent claim 2 is respectfully requested because it has been canceled and, therefore, the rejection is moot.

The withdrawal of the 35 U.S.C. § 102(b) rejections of dependent claims 3 – 5 and 9 - 20 is respectfully requested as each depends from allowable independent claim 1 as amended, among other reasons.

Claim 4 is additionally allowable because *Hunsicker* fails to disclose, either expressly or inherently, the use of a high shear granulator. Contrary to what the Examiner's arguments regarding the high shear granulator seem to imply (Office Action at 4 – 5), the claims in the application do not recite a product-by-process claim. Rather, these are method claims and the use of a high shear granulator is not disclosed in *Hunsicker* (nor in *Anderson*, for that matter). As part of the methods disclosed and recited in the claims, the high speed shearing action of this type of granulator ensures better mixing and, therefore, allows a significant reduction in the amount of binder used as a result of that enhanced mixing (¶ 16 – 18); better management of particle size (¶ 6); and less sensitivity to temperature (¶ 25). This in turn allows a greater concentration of tocopheryl succinate, as set forth in the specification in ¶ 16 – 18. Therefore, the specification identifies the problem to be solved, one that the prior art, expressly *Hunsicker*

(¶¶ 5 – 7), did not solve, and sets forth the solution and the unexpected result of a significantly reduced amount of binder as compared to other methods.

Claim 16 is additionally allowable because *Hunsicker* fails to disclose, either expressly or inherently, the step of establishing a bowl temperature in the granulator between about 30 – 32 degrees C. *Hunsicker* expressly states that “[t]he use of heated gases to fluidize the bed, e.g., air above about 30° C is to be avoided because elevation of the temperature of the bed results in a material that is not susceptible to fluidization” and that the “outlet temperature does not exceed 30° C.” Col. 5, ln. 19 – 35. Thus, *Hunsicker* fails to disclose the range recited in claim 16. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985); M.P.E.P. § 2131.03(III).

Claim 20 is additionally allowable for the reasons set forth above regarding claim 4.

Amended independent claim 21 recites a method that includes, *inter alia*, the steps of spraying the solution onto the tocopheryl succinate substance in a high shear granulator and mixing the solution with the tocopheryl succinate substance in the high shear granulator to produce a mixture.

As discussed above vis-à-vis claim 4, *Hunsicker* (and *Anderson*, for that matter) fails to disclose, either expressly or inherently, the use of a high shear granulator. Therefore, because *Hunsicker* fails to disclose each and every element of amended independent claim 21, the withdrawal of the 35 U.S.C. § 102(b) rejection of claim 21 is respectfully requested.

The withdrawal of the 35 U.S.C. § 102(b) rejections of dependent claims 22 and 32 is respectfully requested because each has been canceled and, therefore, each rejection is moot.

The withdrawal of the 35 U.S.C. § 102(b) rejections of dependent claims 23 – 31 is respectfully requested as each depends from allowable independent claim 21 as amended, among other reasons.

II. Rejection of Claims 6 – 8 and 42 – 44 Under 35 U.S.C. § 103(a) as Obvious over Hunsicker in view of Anderson

The Examiner rejects claims 6 – 8 under 35 U.S.C. § 103(a) as being unpatentable over *Hunsicker* as applied to claims 1-5 and 9-32 above and further in view of U.S. Patent No. 2,791,584 to Anderson *et al.* (hereinafter “*Anderson*”).

An obviousness determination depends on, among other things: (1) the scope and content of the prior art; and (2) the differences between the claimed invention and the prior art. Graham v. John Deere Co., 383 U.S. 1, 17 (1966); KSR Int’l co. v. Teleflex Inc., 127 S. Ct. 1727, 1734; 82 U.S.P.Q.2d 1385 (2007).

The withdrawal of the 35 U.S.C. § 103(a) rejections of dependent claims 6 – 8 is respectfully requested as each depends from allowable independent claim 1 as amended, among other reasons.

The Office Action does not set forth clearly the statutory authority or the reasons claims 42 – 44 stand rejected or whether it is under *Hunsicker* or *Anderson* or both. Regardless, the discussion above vis-à-vis claim 4 sets forth that the **method** claims recite a high shear granulator and are not a product-by-process claim for tocopheryl succinate. In addition, neither *Hunsicker* nor *Anderson* disclose, either expressly or inherently, any method of using a high shear granulator to make tocopheryl succinate. Further, Applicants set forth the improved results obtained through the use of the disclosed methods with a high shear granulator over the prior art

including, expressly, *Hunsicker*. Thus, for these reasons and others, the use of a high shear granulator is not obvious and the withdrawal of the 35 U.S.C. § 103(a) rejection of independent claim 42 is respectfully requested.

The withdrawal of the 35 U.S.C. § 103(a) rejections of dependent claims 43 – 44 is respectfully requested as each depends from allowable independent claim 42, among other reasons.

CONCLUSION

In view of the foregoing, Applicants believe claims 1, 3 – 21, 23 – 31, and 42 – 44 as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

A petition for a 1-month extension of time is submitted with this response, along with the associated fee. If necessary, any underpayments or overpayments under 37 C.F.R. 1.17(a) may be debited or credited to the deposit account 08-2665 as necessary.

Dated this 22nd day of April, 2009.

Respectfully submitted,

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